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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/911,656	07/24/2001	Atsushi Akiyama	01439/LH	3827
1933	7590	08/25/2005	EXAMINER	
FRISHAUF, HOLTZ, GOODMAN & CHICK, PC 220 5TH AVE FL 16 NEW YORK, NY 10001-7708			LETT, THOMAS J	
			ART UNIT	PAPER NUMBER
			2626	

DATE MAILED: 08/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/911,656

**Applicant(s)**

AKIYAMA ET AL.

**Examiner**

Thomas J. Lett

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 10-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: Detailed Action.

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments with respect to claims 1-9 have been considered but are moot in view of the cancelled claims. Examiner acknowledges new claims by Applicant and presents additional prior art(s) for the new claims.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 10-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Maeda (USPN 6,437,843).

With respect to claim 10, Maeda discloses a facsimile apparatus (internet facsimile apparatus 1, col. 3, lines 6-24) capable of performing facsimile communications through a computer network (col. 2, lines 57-66), said apparatus comprising:

a storage section (RAM 12, col. 3, lines 24-27);

an address acquisition section configured to acquire addresses of other parties of the facsimile communications during the facsimile communications (list of Fig. 6 showing other fax addresses to initiate transmission);

an address storage control section (see "INTERNET ADDRESS" of Fig. 6) configured to store all of the addresses acquired by the address acquisition section for a given time period in the storage section so as to maintain a communication history (see "DATE and TIME of ACQUISITION" of Fig. 6) and

an address designation section configured to selectively designate an address of a desired one of the other parties from the addresses stored in the storage section and to set the designated address as a designated other party address (using one-touch number of Fig. 6 to designate a fax party).

With respect to claim 11, Maeda discloses a facsimile apparatus according to claim 10, further comprising:

a communication-capability acquisition section (RAM 12 of Maeda in Fig. 6) configured to acquire communication-capability information of the other parties during the facsimile communications;

a communication-capability storage control section ("Internet Fax Function" in Fig. 6) configured to store the communication-capability information acquired by the communication-capability acquisition section in the storage section in correspondence with the corresponding addresses acquired by the address acquisition section;

wherein when new communication-capability information corresponds to an address already stored in the storage section in correspondence with communication-capability information, and

if the new communication-capability information is different from the already-stored communication-capability information, the address storage control section updates the already-stored communication capability information to coincide with the new communication-capability information

Maeda discloses a RAM 12 obtaining capability information of destination apparatuses by transmitting capability requests to destination apparatuses and receiving notification from destination apparatuses using a mail protocol (col. 6, lines 21-26), specifically SMTP (col. 6, line 23), also teaching converting a file according to the capability of the receiving apparatus (col. 6/lines 26-28) and to transmit the converted sending data as e-mail using SMTP (col. 6, lines 29-30). Examiner notes that the Table of Fig. 6 is updated and a date-stamp is associated with the update.

With respect to claim 12, Maeda discloses a facsimile apparatus according to claim 10, further comprising a communication-capability storage control section configured to store communication-capability information in the storage section in correspondence with the corresponding addresses of the other parties ("Internet FAX capability" stores capability of other parties, col. 6, lines 10-12), said communication-capability information being included in affirmation information transmitted from the other parties after completion of the facsimile communications (the information is received by the CPU 5 as a capability notification, col. 6, lines 24-26);

wherein when new communication-capability information corresponds to an address already stored in the storage section in correspondence with communication-capability information, and the new communication-capability information is different from the already-stored communication-capability information, the address storage control section updates the already-stored communication capability information to coincide with the new communication-capability information (Examiner notes that the Table of Fig. 6 is updated and a date-stamp is associated with the update. The capability information for any address is updated when the apparatus of Maeda polls the capabilities of network devices, col. 6, lines 21-26).

With respect to claim 13, Maeda discloses a facsimile apparatus according to claim 10, wherein the storage section comprises a recipient-address area (Fig. 3, Line 5) and an originator-address area (Fig. 3, Line 5); and

wherein when the other party of one of the facsimile communications is a recipient of the facsimile communication, the address of the other party is stored in the recipient-address area (see Fig. 3), and when the other party of one of the facsimile communications is an originator of the facsimile communication, the address of the other party is stored in the originator-address area (see Fig. 3).

With respect to claim 14, Maeda discloses a facsimile apparatus according to claim 13, wherein the address designation section receives a designation of one of the recipient-address storage area and the originator-address storage area,

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displays a list of addresses stored in the designated one of the storage areas, receives a request to selectively designate the desired address from the addresses in the displayed list (list of Fig. 6 showing other fax parties to initiate transmission), and sets the designated address (using one-touch number of Fig. 6 to designate a fax party) from the list as the designated other party address.

With respect to claim 15, Maeda discloses facsimile apparatus according to claim 13, wherein the storage section further comprises an abbreviated-dialing registration area (see "ONE-TOUCH NUMBER" section of Fig. 6); and

wherein the facsimile apparatus further comprises an address registration section which receives a designation of a desired address stored in one of the recipient-address storage area (see "INTERNET ADDRESS" of Fig. 6) and the originator-address storage area and

registers the designated address in the abbreviated-dialing registration area (see registered address of "INTERNET ADDRESS" of Fig. 6).

With respect to claim 16, Maeda discloses facsimile apparatus according to claim 15, wherein the address registration section receives a designation of one of the recipient-address storage area and the originator-address storage area,

displays a list of addresses stored in the designated one of the storage areas (list of Fig. 6 showing other fax parties to initiate transmission),

receives a request to selectively designate the desired address from the addresses in the displayed list and registers the designated address from the list in the

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abbreviated-dialing registration area (using one-touch number of Fig. 6 to designate a fax party).

Claim 17, a method claim, is rejected for the same reason as claim 10.

Claim 18, a method claim, is rejected for the same reason as claim 11.

Claim 19, a method claim, is rejected for the same reason as claim 12.

Claim 20, a method claim, is rejected for the same reason as claim 13.

Claim 21, a method claim, is rejected for the same reason as claim 14.

Claim 22, a method claim, is rejected for the same reason as claim 15.

Claim 23, a method claim, is rejected for the same reason as claim 16.

Claim 24, an apparatus means claim, is rejected for the same reason as claim 10.

Claim 25, an apparatus means claim, is rejected for the same reason as claim 11.

Claim 26, an apparatus means claim, is rejected for the same reason as claim 12.

Claim 27, an apparatus means claim, is rejected for the same reason as claim 13.

Claim 28, an apparatus means claim, is rejected for the same reason as claim 14.

Claim 29, an apparatus means claim, is rejected for the same reason as claim 15.



Claim 30, an apparatus means claim, is rejected for the same reason as claim 16.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Lett whose telephone number is (571)272-7464. The examiner can normally be reached on 7-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams can be reached on (571)272-7471. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TJL

TJL

~~KIMBERLY WILLIAMS~~  
~~SUPERVISORY PATENT EXAMINER~~  
KAW Williams  
KIMBERLY WILLIAMS  
SUPERVISORY PATENT EXAMINER